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TO: Examiner Allen C. Ho
U.S. Patent and Trademark Office

FROM: Michael P. Sandomato

RE: U.S. Patent Appln. Sereial No. 10/067,753
Our Ref.: 01873.000049

FAX NO.: 703-872-9318

DATE: January 8, 2004

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

AARON BRATSLAVSKY ET AL.

Application No.: 10/067,753

Filed: February 8, 2002

For: DENTAL X-RAY POSITIONING
USING ADHESIVES

Examiner: Allen C. Ho

Group Art Unit: 2882

December 5, 2003

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

Sir:

In response to the Office Action dated November 20, 2003, Applicants have the following comments:

The Office Action is a first Action in this continuation application, but was made Final pursuant to MPEP § 706.07(b), because according to the Examiner "All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application." (November 20 Office Action at 12).

However, Applicants respectfully point out that after setting forth the conditions under which the claims of a new application may be finally rejected in a first Office Action, MPEP 706.07(b) goes on to say in its second paragraph:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

MPEP 706.07(b) (emphasis added).

In an Amendment After Final Action dated August 18, 2003, Applicants amended the pending claim to recite "a pressure sensitive adhesive." Following that, in an Advisory Action dated October 1, 2003, the Examiner refused entry of the Amendment After Final, finding that the amendments "raise new issues that would require further consideration and/or search" (Box 2.(a)), and noting particularly that "The new limitation 'pressure sensitive' raises new issue (sic) and would require further consideration and search." (Advisory Action at 2).

Applicants respectfully submit that because the "pressure sensitive" limitation was found by the Examiner to raise new issues, and in accordance with the second paragraph of MPEP § 706.07(b), the first Office Action in the present application may not properly be made Final. Accordingly, Applicants respectfully request the Examiner to withdraw the Finality of the outstanding Office Action, and to issue a new, non-final Office Action.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,


Attorney for Applicants

Registration No. 35,345

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